



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,395	03/01/2004	Dennis Davidson	193567	2574

7590 03/27/2006

Robert E. Cannuscio
DRINKER BIDDLE & REATH LLP
One Logan Square
18 th & Cherry Streets
Philadelphia, PA 19103-6996

EXAMINER

FETSUGA, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3751

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/791,395

Applicant(s)

DAVIDSON, DENNIS

Examiner

Robert M. Fetsuga

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3751

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the "shaped to substantially enclose" language set forth in claim 1 (and similarly claim 20) could not be found in the specification. Applicant is reminded claim terminology in mechanical cases should appear in the descriptive portion of the specification by reference to the drawing(s).

Applicant argues at page 4 of the response filed February 21, 2006 paragraph 0009 describes this feature. The examiner can not agree. Notwithstanding the actual claim language not being present in the noted paragraph (particularly claim 20), neither the specification nor drawings teach one what particular structure this language is intended to encompass. Fig. 3 merely illustrates a plunger wrapped in a film.

2. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 3751

The claim recites a cover that "consists of a single layer of the flushable paper material joined to a single layer of the film soluble in water." This language contradicts the original disclosure at paragraph 0005, for example, and is therefore considered to be new matter.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 5, 14-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Laumann '064.

The Laumann '064 ('064) reference discloses a layer of flushable paper (col. 4 lns. 3-6); a soluble film (col. 3 lns. 44-50); adhesive (col. 4 lns. 6-9); and a grip area/tab (col. 7 lns. 7-17), as claimed. Re claim 1, the '064 material is

Art Unit: 3751

capable of being used "to substantially enclose a plunger" in the functionally recited manner.

Applicant argues at page 6 of the response Laumann discloses a sheet comprising three layers where instant claim 1 only recites a sheet comprising two layers. The examiner agrees, however, such a fact situation indicates applicant's claim 1 is anticipated by the Laumann disclosure. Applicant further argues at page 6 of the response Laumann does not disclose a water soluble film. The examiner can not agree and notes the title of the Laumann disclosure clearly contradicts applicant's position. Furthermore, Laumann teaches use of polyvinyl alcohol which appears consistent with applicant's invention (claim 5, for example).

5. Claims 4, 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over '064.

Re claim 4, the choice of number of layers would appear an obvious choice to be made. Re claim 6, the choice of dissolution rate would appear an obvious choice to be made. Re claim 17, the choice of shape would appear an obvious choice to be made.

Applicant argues at page 7 of the response Laumann does not suggest a two layer sheet without a wax coating as set forth in

Art Unit: 3751

claim 1. The examiner can not agree, and notes Laumann suggests this subject matter at column 3, lines 44-50 (as noted supra).

6. Claims 1-9, 12, 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over '064 and Wilkins, Jr.

Re claims 7-9, the choice of color would appear an obvious choice to be made. Note lines 29-37 in column 3 of Wilkins.

Re claim 12, the Wilkins, Jr. (Wilkins) reference explicitly teaches a water soluble material used to construct a bag which could be used to contain a plunger as functionally recited in the claim.

Re claim 19, although the '064 water soluble material is not infused, as claimed, attention is yet again directed to Wilkins which discloses an infused water soluble material (col. 3 lns. 29-40). Therefore, in further consideration of Wilkins, it would have been obvious to one of ordinary skill in the water soluble material art to infuse the '064 water soluble material in order to facilitate handling and disposal.

Applicant argues at page 8 of the response the only soluble layer taught by Wilkins is a hot water soluble layer. The examiner can not agree, and notes lines 44-52 in column 5 of Wilkins.

Art Unit: 3751

7. Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over '064 and Wilkins as applied to claim 12 above, and further in view of Waters.

Although the '064 bag does not include a concave bottom end, as claimed, attention is directed to the Waters reference which discloses an analogous bag which further includes a concave bottom end (Fig. 4). Therefore, in consideration of Waters, it would have been obvious to one of ordinary skill in the bag art to associate a concave bottom end with the '064 bag in order to provide stability. Re claim 11, the Waters concave bottom is capable of conforming to a plunger cup, especially since this claim language connotes no definite structure as is evident from an inspection of the instant specification at 0028, lines 6-9.

Applicant has not substantively argued this ground of rejection.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over '064 and Oberstein.

Although the '064 water soluble material does not include a resealable seam, as claimed, attention is directed to the Oberstein reference which discloses an analogous water soluble material which further includes a resealable seam 34.

Therefore, in consideration of Oberstein, it would have been

Art Unit: 3751

obvious to one of ordinary skill in the water soluble material art to associate a resealable seam the '064 water soluble material in order to facilitate use.

Applicant argues at page 9 of the response Oberstein teaches a readily separated, adhesive seam. The examiner agrees, and notes such a seam meets the claimed "resealable" limitation as this claim language connotes no definite structure.

9. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

10. The grounds of rejection have been reconsidered in light of applicant's arguments, but are still deemed to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3751

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

A handwritten signature in black ink, appearing to read "Robert M. Fetsuga", is positioned above the printed name.

Robert M. Fetsuga
Primary Examiner
Art Unit 3751